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EXAMINER

MANNING, JOHN

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,138

Applicant(s)

RUSSELL ET AL.

Examiner

John Manning

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/16/2006 have been fully considered but they are not persuasive.

With respect to claim 1 and 30 Applicant argues "linuma does not disclose the step of 'transmitting, for playback by said member, said program file **over a computer network** to said member as streaming media with said streaming media tool". linuma discloses network communications over a CATV system, which meets the limitation of a computer network (See: Col 8, Lines 45-55). Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection. The Applicant fails to adequately traverse the Official Notices relied upon in the previous Office Action mailed 12/14/2005. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating **why** the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2623

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-8, 15-17, 19, 21-23, 29-33, 35-37 and 44-46 are rejected under 35 U.S.C. 102(e) as being anticipated by linuma et al. (US Pat No 6,230,325).

In regard to claims 1 and 30, linuma discloses an "information network system and a broadcasting receiving user terminal by which bidirectional communication can be established between a user terminal and a data base center and between the data base center and a broadcasting station so that a user can enjoy a service provided from the data base center and enjoy bidirectional communication in regard to broadcasting" (abstract). The claimed step of "broadcaster obtaining a bundle that includes at least one application tool" is met by Figure 1, Item 300b. The claimed step of "at least one storage device" is met by Figure 1, Item 300a. The claimed step of "at least one streaming media tool" is met by Figure 1, Item 300c. The claimed step of "creating at least one program file with said application tool" is met by Figure 1, Item 300. The claimed step of "storing said program file on said storage device" is met by Figure 1, Item 300a. "Referring first to FIG. 1, there is shown a basic construction of an information network system to which the present invention is applied. The information network system shown includes a broadcasting center 400 for providing broadcasting programs to users, a data base center 300 for providing data bases to users, and a large number of broadcasting receiving user terminals 100 (only two are shown in FIG. 1) having a function of receiving a broadcasting program from the broadcasting center 400 and another function of bidirectionally communicating with the data base center 300

Art Unit: 2623

via a network 200. Also the broadcasting center 400 and the data base center 300 are connected to each other by a network 500 which allows bidirectional communication so that they can communicate with each other. The broadcasting center 400 includes a broadcasting program editing section 400a for editing a broadcasting program, a transmission section 400b for transmitting a broadcasting signal of the edited broadcasting program by wireless or by a cable, and a guide information addition section 400c for adding guide information for accessing to a data base to a broadcasting signal for a particular program to be transmitted from the transmission section 400b. The guide information may include a broadcasting program ID (identification number or code) for identifying the broadcasting program, a telephone number of the data base center 300, and a data base server ID for designating a data base to be addressed. The data base center 300 includes a data base storage section 300a, a data base management section 300b for managing the data base storage section 300a, and a network communication section 300c for bidirectionally communicating with the large number of user terminals 100 via the network 200" (Col 4, Lines 48-67; Col 5, Lines 1-14). The claimed step of "registering a prospective viewer as a member" is met by Figure 7. The claimed steps of "providing the member with at least one downlink channel to view", "associating said program file with said downlink channel" and "transmitting, for playback by said member, said program file over a computer network to said member as streaming media with said steaming media tool" are met by Figure 1, Item 200. "Each of the user terminals 100 includes a broadcasting signal reception section 100a for receiving a broadcasting signal transmitted by wireless

or by a cable from the broadcasting center 400, a guide information extraction section 100b for separating and extracting, from the received broadcasting signal, guide information added to the broadcasting signal by the broadcasting center 400, a user information storage section 100c for storing user information peculiar to a user of the user terminal 100, and a network communication section 100d for accessing a data base of the data base center 300 via the network 200 based on the guide information extracted by the guide information extraction section 100b and the user information read out from the user information storage section 100c and for receiving a response from the data base center 300. The user information may include the name, an address, a user ID, a password and so forth of the user" (Col 5, Lines 14-36). "Each of the user terminals 100 can be realized also by modifying an existing television receiver with a teletext reception function or a television receiver for the EDTV-II system so as to additionally have a network communication function or by adding program software for extraction of guide information and for network communication to a personal computer with a built-in television reception function. Also the antenna may be replaced by a cable for a CATV system. Further, also network communication and telephoning are possible with a bidirectional CATV system" (Col 8, Lines 45-55). The disclosed network communications over a CATV system meet the limitation of a computer network.

Claims 2-3 and 31-32 are met by that discussed above for claims 1 and 30.

In regard to claims 4, 7, 16, 17, 33, 36, 45 and 46, linuma discloses debiting the credit card account of a member. "Further, if a credit card is used, then the necessity

for inputting of an account number for settlement can be eliminated, which further improves the convenience to the user" (Col 7, Lines 19-22).

In regard to claims 6 and 35, linuma discloses that upon verification of the users credentials, the view has a "pass" to view the program files.

In regard to claims 8 and 37, the broadcaster 400 includes program information which meet the limitation of auxiliary files associated with said program file.

In regard to claims 15 and 44, linuma discloses "setting up an account for said member and receiving funds from said member for said account" (Col 10, Lines 18-45; Col 7, Lines 19-22).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 11-14, 34, 40-43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over linuma et al. in view of Ellis et al (US Pat App Pub No 2004/0117831).

In regard to claims 5 and 34, linuma fails to disclose the allowing the user to search the database. Ellis teaches allowing a user to search the database so as to facilitate the acquisition of a user's preferred program (Paragraphs 0131, 0136 and 0137). Consequently, it would have been obvious to one of ordinary skill in the art to

implement linuma with allowing the user to search the database for the stated advantage.

In regard to claims 11-12 and 40-41, linuma fails to disclose allowing the user to add channels or programs to a favorites list. Ellis teaches allowing the user to add channels or programs to a favorites list so as to allow the user to quickly find programs of interest (Paragraphs 0116, 0144 and 0153). Consequently, it would have been obvious to one of ordinary skill in the art to implement linuma with allowing the user to add channels or programs to a favorites list for the stated advantage.

In regard to claims 13 and 42, linuma fails to disclose receiving members rating of a program. Ellis teaches receiving members rating of a program so as to highlight programs with high rating and hide programs with low rating (Paragraphs 0156, 0157 and 0158). Consequently, it would have been obvious to one of ordinary skill in the art to implement linuma with receiving members rating of a program for the stated advantage.

In regard to claims 14 and 43, linuma fails to disclose allowing the allowing the member to email the broadcaster. Ellis teaches allowing the allowing the member to email the broadcaster so as to allow the broadcaster to receive feedback (Paragraph 0116). Consequently, it would have been obvious to one of ordinary skill in the art to implement linuma with allowing the allowing the member to email the broadcaster for the stated advantage.

6. Claims 9-10, 18, 38, 39, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over linuma et al.

In regard to claims 9 and 38, linuma fails to disclose allowing the member to create a member page on the server. However, the examiner takes Official Notice that it is notoriously well known in the art to allow a member to create a member page on the server so as to allow the user to customize the layout of the content. Consequently, it would have been obvious to one ordinary skill in the art to implement linuma with allowing the member to create a member page on the server for the stated advantage.

In regard to claims 10 and 39, linuma fails to disclose allowing the member to add a guest. However, the examiner takes Official Notice that it is notoriously well known in the art to allow a member to add a guest so as to promote the service to potential customers. Consequently, it would have been obvious to one ordinary skill in the art to implement linuma with allowing the member to add a guest for the stated advantage.

In regard to claims 18 and 47, linuma discloses charging a user for the provided services. linuma fails to disclose using a Paypal transaction. However, the examiner takes Official Notice that it is notoriously well known in the art to allow to use Paypal transactions so as to provide a convenient method of payment to the user. Consequently, it would have been obvious to one ordinary skill in the art to implement linuma with Paypal transactions for the stated advantage.

Claims 19, 21-23, 29 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over linuma in view of Cobbley (US Pat No 5,818,510).

In regard to claim 19, the recited limitations are met by that discussed for claims 1 and 30 except for the claimed limitation of "means for said member transmitting a

Art Unit: 2623

request to receive a program file to said server over said uplink channel by..." and "means for said server transmitting said selected program file to said member over said downlink channel as streaming media, by..." linuma fails to explicitly disclose this recited limitation. Cobbley teaches "means for said member transmitting a request to receive a program file to said server over said uplink channel by..." and "means for said server transmitting said selected program file to said member over said downlink channel as streaming media, by..." so as to allow "individual users to watch only those portions of the broadcast which are of interest to them without requiring them to watch the entire broadcast" (Col 1, Lines 39-42; Also see: Col 9, Lines 60-67). Consequently, it would have been obvious to one ordinary skill in the art to implement linuma "means for said member transmitting a request to receive a program file to said server over said uplink channel by..." and "means for said server transmitting said selected program file to said member over said downlink channel as streaming media, by..." for the stated advantage.

In regard to claims 21 and 23, linuma discloses charging a member for the service. "Further, if a credit card is used, then the necessity for inputting of an account number for settlement can be eliminated, which further improves the convenience to the user" (Col 7, Lines 19-22). linuma also discloses that upon verification of the users credentials, the view has a "pass" to view the program files.

In regard to claim 22, linuma discloses allowing the member to browse the program files (Col 6, Lines 10-27).

Claims 29 and 50 is met by that discussed for claim 19.

Art Unit: 2623

In regard to claim 51, the combined teaching fails to disclose a file format that is one of Real, Windows or QuickTime. However, the examiner takes Official Notice that it is notoriously well known in the art to use a file format that is one of Real, Windows or QuickTime so as to generate content for a digital media system conforming to format standards. Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with the use of a file format that is one of Real, Windows or QuickTime for the stated advantage.

Claims 20, 24-26 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over linuma in view of Cobbley and further in view of Ellis.

In regard to claim 20, the combined teaching fails to disclose allowing the user to add channels or programs to a favorites list. Ellis teaches allowing the user to add channels or programs to a favorites list so as to allow the user to quickly find programs of interest (Paragraphs 0116, 0144 and 0153). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with allowing the user to add channels or programs to a favorites list for the stated advantage.

In regard to claims 24-26, the combined teaching fails to disclose receiving members rating of a program. Ellis teaches receiving members rating of a program so as to highlight programs with high rating and hide programs with low rating (Paragraphs 0156, 0157 and 0158). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with receiving members rating of a program for the stated advantage.

In regard to claims 27-28, the combined teaching fails to disclose compiling statistics based on the users rating and reporting the statistics to the broadcasters. However, the examiner takes Official Notice that it is notoriously well known in the art to compile statistics based on users ratings and reporting the statistics to broadcasters so as to the determine demographic and psychographic information of the systems users allowing the broadcasts to target advertisements. Consequently, it would have been obvious to one ordinary skill in the art to implement linuma compiling statistics based on the users rating and reporting the statistics to the broadcasters for the stated advantage.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM
June 6, 2006



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